

Ober, Kaler, Grimes & Shriver
Attorneys at Law

120 East Baltimore Street
Baltimore, MD 21202-1643
410-685-1120 / Fax 410-547-0699
www.ober.com



3-20-07

DAF/

Royal W. Craig
rwraig@ober.com
410-347-7303

Offices in
Maryland
Washington, D.C.
Virginia

EV832997275US

TRANSMITTAL VIA EXPRESS MAIL:

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: U.S. Patent Application 10/825,836 for "LIGHTING ACCENT RING";
From(Provisional Patent Application 60/463,512; Filed: April 16, 2003); Filed:
April 17, 2004 Applicant: Wade C. Horton.

Dear Sir:

Enclosed, please find the following:

1. Three (3) copies of Appeal Brief; Inclusive of Appendix A: Claims Under Appeal, Appendix B: Evidence, Appendix C: Related Proceedings (Filed in triplicate).
2. Our post card. Please date stamp and return.

Please charge any fees to our Deposit Account 50-3391 (a duplicate copy of this charge authorization is attached.) Thank you for your cooperation and assistance.

Respectfully submitted,

Royal W. Craig
Reg. 34,145

I HEREBY CERTIFY that on March 19, 2007, one copy of the above-referenced documents were transmitted by Express Mail to the United States Patent and Trademark Office.

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re U.S. Utility Patent Application of
Horton, Wade C.

Art Unit: 3637

Appln. No. 10/825,836

Examiner: Mai, Lanna

Filed: 2004 April 16

For: LIGHTING ACCENT RING



* * *

March 19, 2007

APPEAL BRIEF

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

Further to Appellant's Notice of Appeal filed 18 January 2007, his Appeal Brief is submitted herewith. This is an Appeal from the final rejection of claims 1-4, 6, 7, 9-11, 13, and 14 of the subject application. No claims stand allowed.

REAL PARTY IN INTEREST

The real party in interest is Mr. Wade Horton, 2922 Rosalie Avenue, Baltimore, Maryland 21234-7615.

RELATED APPEALS AND INTERFERENCES

Appellants aver that there are no other prior or pending appeals, interferences or judicial proceedings known to appellants, the appellants' legal representative, or assignee which may be

related to, directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-4, 6, 7, 9-11, 13, and 14 are pending in this application. The rejection of all of the claims 1-4, 6, 7, 9-11, 13, and 14 is being appealed. Please see Appendix A for a copy of the claims under Appeal.

STATUS OF AMENDMENTS

A second and final Official Action was mailed 18 October 2006. Together with his Notice of Appeal, Appellant filed a Response under Rule 1.116 with remarks. The Rule 1.116 Response was not entered by Advisory Action dated 07 February 2007.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is an accent frame 5 for an inset article (i.e. recessed lighting fixture (FIG. 2, Ref. #21), ducting system, etc. The accent frame 5 may take on any geometric shape or the shape of any object including a star, flower, or house. FIG. 1 is a plan view of one embodiment of the present invention, namely a star-shaped accent frame 5. FIG. 2 is a perspective view of a flower-shaped accent frame 5 for a recessed lighting fixture 21, showing the means of installation with the various components separated. The inset article 21 has a standard finishing ring 53 to cover the joint between the inset article 21 and the cutout 20 to cover up any imperfections in the cutout 20. [page 7, para 0006] The accent frame 5 is larger than the finishing ring 53. Thus, the accent frame 5 of the present invention surrounds the cutout

20, and serves as a decorative transition between the surrounding structure 30 and the finishing ring 53. The frame 5 also covers up any imperfections in the finish or cut of the surrounding ceiling, wall, or floor 30 resulting from the installation process of the inset article 21, that are not covered by the finishing ring 53, and thereby provides an aesthetically pleasing appearance.

[page 8, para 0002]

As seen in FIGs. 1-2, the accent frame 5 is comprised of a thin sheet of rigid material. The frame 5 is provided with an inner edge defining an aperture 6, which generally corresponds in size and shape to the cutout 20 in the wall, ceiling, or floor structure 30 for the inset article 21. A lip 10 extends rearward from the aperture 6 into the cutout 20 to serve as a proper guide for positioning. An outer edge 7 of the accent frame 5 defines a patterned perimeter in a geometric shape or an object-shape such as a star (FIG. 1), a flower (FIG. 2), or a house (FIG.3). Additionally, the frame 5 can be colored (by painting or molding from pigmented material) with one or more colors, which depict the object suggested by the shape of the patterned perimeter.

[page 8, para 0004]

The material of the accent frame 5 may be designed to sit flush against the wall, ceiling, or floor structure 30 and sufficiently thin so that no perceptible dimension of thickness is apparent to an observer. The accent frame 5 may be formed with a slight convex curvature to insure that it remains in contact with the surrounding wallboard when the inner edge is pressed against the wall, ceiling or floor 30 by the finishing ring 53. [page 9, para 0001] Alternately, the accent frame 5 may slightly flare away from the structure 30 to provide an aesthetically pleasing depth or texture to the frame. FIG. 2 shows that the frame 5 may flare out, for example, in the shape of a blooming flower. [page 9, para 0002]

The frame 5 may be constructed of lightweight materials including metal, plastic, wood, or a combination thereof, such that it is sufficiently rigid to maintain a horizontal or vertical orientation parallel to the cutout 20 and to remain in contact with the wall or ceiling 30 when installed. Additionally, the frame 5 may be cut to shape or formed by injection molding. [page 10, para 0002] The frame 5 is preferably formed with a thickness of approximately 1 mm, which is sufficiently thin as not to be readily visible when viewed along a line parallel to the surface of the wall, ceiling, or floor 30. This thin frame 5 can be easily installed between the finishing ring 53, provided by the manufacturer, and the ceiling 30 without altering or purchasing a custom accent ring. [page 10, para 0003]

In use, the accent frame 5 can be easily installed by a homeowner by centering the frame aperture 6 upon the cutout 20 in the wall, ceiling, or floor 30, created for inseting the article 21. The lip 10 assists in positioning the frame 5. A typical recessed lighting fixture 21 includes a finishing ring 53 that connects to the recessed lighting fixture 21 by expandable tension clips/slots 54a, 54b. The finishing ring 53 is placed over the accent frame 5 and attached to the recessed lighting 21 using the clips/slots 54a, 54b. The finishing ring 53 secures the frame 5 in place. A portion of the accent frame 5 adjacent to the aperture 6 will be confined between the finishing ring 53 and the wall or ceiling 30, and the remaining portion of the frame 5 will be disposed about the area surrounding the fixture 21. [page 9, para 0003]

Independent claim 1 is an apparatus claim based on the accent frame 5 for framing an article inset 21 within a cutout 20 of a structure 30, said inset article 21 including a finishing ring 53 for providing a transition from said article 21 to said structure 30. [page 7, para 0006] The accent frame 5 requires:

a rigid thin sheet of material larger in size than the finishing ring 53, said rigid thin sheet having an outer edge 7 defining an object-shape and a convex inner edge defining an aperture 6 having a lip 10 for proper positioning with said cutout 20 [page 8, para 0003-0004], wherein said cutout 20 comprises slots 54b and said finishing ring 53 comprises expandable tension clips 54a for insertion through said aperture 6 and said slots 54b thereby securing said frame 5 in place between said finishing ring 53 and about the cutout 20 and against the structure 30; whereby said accent frame 5 serves as an aesthetically pleasing backdrop to said finishing ring 53 and serves to cover up any imperfections in the finish or cut of the surrounding structure 30. [page 9, para 0003]

The above constitute a concise explanation of the invention defined in independent claim 1 and depending claims 2-4, 6, 7, 9-11, 13, and 14 involved in the Appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

There are two categorical issues set forth as follows:

1st: Whether claims 1-4, 6-7, 9-10, 13-14 are obvious under 35 U.S.C. 103(a) in view of U.S. Patent Nos. 5,975,853 to Lackey and 6,474,846 to Kelmelis et al.?

2nd: Whether claim 11 is obvious under 35 U.S.C. 103(a) in view of U.S. Patent Nos. 5,975,853 to Lackey, 6,474,846 to Kelmelis et al., and 6,152,413 to Gretz?

APPELLANTS' ARGUMENT

1st: The Examiner clearly erred in rejecting claims 1-4, 6-7, 9-10, 13-14 as obvious under 35 U.S.C. 103(a) in view of U.S. Patent Nos. 5,975,853 to Lackey and 6,474,846 to Kelmelis et al.

A. Lackey '853 patent

The Lackey '853 patent discloses a ceiling aperture cover including a shell and back panel that attach together via posts and fasteners. The exterior of the shell has a hub which fits within an aperture in the interior of the shell, wherein the hub attaches to a mounting plate attached to a junction box connected to the ceiling. A light fixture or ceiling fan is attached to the mounting plate after a *circular cover is wedged between the junction box and mounting plate*.

a. The Lackey '853 patent is non-analogous art

The Lackey '853 patent is non-analogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Applicant's field of endeavor is accents for ceiling fans. Lackey '853 is directed to covering the aperture associated with a ceiling fan or a light fixture. This is a different application and field. "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). Pertinence is not reduced by differences such as mere change of size and substitution of material. In re Wolfe, 251 F.2d 854, 856 (CCPA 1958). The Lackey '853 device does not *frame* an article inset (such as a light fixture) within a cutout of a structure, rather it is a cover that attaches to a mounting plate for *mounting* an article such as a light fixture or ceiling fan. Therefore, Lackey '853 is not reasonably pertinent because the matter with which it deals (obscuring), logically

would not have commended itself to an inventor's attention in considering the problem of accentuating.

B. Kelmelis et al. '846 patent

The Examiner acknowledges that Lackey '853 falls short of the present invention, in that the cover lacks a lip for positioning within a cutout of a structure. However, the Examiner combines the Kelmelis '846 patent, crediting it with a lip extending from an aperture of a framing member. The Kelmelis '846 patent discloses a lighting system including a support ring for attachment typically to the underside surface of a lighting fixture containment space, and a finishing ring which can lockably engage the support ring. The finishing ring has a radially extending flange with radially outwardly disposed grooves and a plurality of apertures in the flange. The apertures help hold wall joint compound so that the wall finish can be brought over the radially extending flange and up to a rim, disposed on the same side of the flange which will receive wall joint compound to receive the *custom installation*. The finishing ring also includes slots through the flange. A support ring includes a radially planar portion which will fit against the bottom of a metal accommodation box. In one embodiment, the support ring includes a series of dimples that align within the cutouts of the finishing ring. In another embodiment, the radial portion of the support ring includes a series of threaded apertures, which can align with apertures in the finishing ring, for screws to pass through and fix the two rings together.

a. The combination of the Lackey '853 and Kelmelis '846 patents is improper

The present invention is not a cover as the Lackey '853 device is, nor is the present invention a lighting system that requires custom installation with wall joint compound, and screws or other fasteners as the Kelmelis '846 device is. Rather, the present invention is an

object-shaped accent frame for an article inset within a cutout of the structure. The accent frame simply snaps onto the finishing ring of the article, and does not require any additional fasteners, compounds, etc. to connect the frame to the article. There is no suggestion or motivation for combining the non-analogous Lackey '853 cover with the Kelmelis et al. '846 lighting system to arrive at the accent frame of the present invention. The present invention itself cannot be used to find the suggestion/motivation in the prior art. See In Re Kotzab, 217 F.3d at 1369, 55 U.S.P.Q.2d at 1316. Hindsight is 20-20, however the present invention cannot be viewed through it when analyzing patentability of claims. Pursuant to section 103(a) the mind must be cast back to the time of the invention and only the referenced prior art and the wisdom then-accepted in the field can be used to analyze whether the claims are obvious. See id. Thus, the combination is improper and the Examiner has failed to make a prima facie case of obviousness.

b. The combination of the Lackey '853 and Kelmelis '846 patents still fails to teach or suggest the claimed invention

Even if the combination were proper, Lackey '853 does not teach that which the Examiner gives it credit for. The claimed invention is an object-shaped accent frame comprised of a rigid thin sheet of material larger in size than the finishing ring, and which snaps onto a finishing ring of an inset article to frame the article within a cutout, and also covers imperfections in the structure surrounding the cutout, etc. Specifically, independent claim 1 requires an "accent frame comprising: a *rigid thin sheet of material* larger in size than the finishing ring" and "*said rigid thin sheet having an outer edge defining an object-shape and a convex inner edge defining an aperture having a lip for proper positioning with said cutout*, wherein said *cutout comprises slots* and said *finishing ring comprises expandable tension clips*

for insertion through said aperture and said slots thereby *securing said frame in place between said finishing ring and about the cutout and against the structure*". Contrary to the Examiner's argument, Lackey '853 does not disclose the accent frame required by independent claim 1.

Lackey '853 discloses a ceiling aperture cover including a shell and back panel that attach together via posts and fasteners. The exterior of the shell has a hub which fits within an aperture in the interior of the shell, wherein the hub attaches to a mounting plate attached to a junction box connected to the ceiling. A light fixture or ceiling fan is attached to the mounting plate after a *circular cover is wedged between the junction box and mounting plate*. The Lackey '853 cover does not disclose a "rigid sheet" with a "convex inner edge", and does not suggest these features either. Lackey '853 device covers a ceiling aperture, and facilitates mounting of a light fixture or ceiling fan. Thus, the Lackey '853 device is not structurally adapted for framing an inset article. This is precisely the purpose of the claimed *accent frame*. Kelmelis et al. '846 does not bridge the gap that Lackey '853 has created.

Furthermore, the Examiner misconstrues the object-shaped limitation. The Examiner credits Lackey '853 with teaching an "object-shaped" outer edge. The Examiner contends that the "decorative outer edge" of Lackey is "in the shape of a circular object". However, Lackey merely discloses a circular (geometric) shaped cover. *Merriam-Webster's Dictionary of Law* defines an object as "something material that may be perceived by the senses", and thus the Examiner misconstrues Lackey's geometric-shaped cover as an object-shaped cover. Again, Kelmelis et al. '846 does not bridge this gap.

Since the combination of the Lackey '853 and Kelmelis et al. '846 patents does not teach or suggest the present invention, independent claim 1 is patentably distinguished. Likewise depending claims 2-4, 6-7, 9-10, 13-14 are patentably distinguished.

2nd: The Examiner clearly erred in rejecting claim 11 as obvious under 35 U.S.C. 103(a) in view of U.S. Patent Nos. 5,975,853 to Lackey, 6,474,846 to Kelmelis et al., and 6,152,413 to Gretz.

A. Gretz '413 patent

The Gretz '413 patent discloses a mounting block/electrical box for mounting electrical devices such as ceiling fans, chandeliers, and sconces. The mounting block/electrical box has a generally closed bottom, an open top, an interior volume, and a planar medallion portion about the top periphery of the box. The bottom of the box includes a centrally located mounting hole, at least one means of access for a power cable, and a pair of slots extending into the volume of the box for receipt of and passage therethrough of mounting bolts for an electrical device attached through the box to a structural member, such as a joist or stud using a screw during installation.

a. The Gretz '413 patent is non-analogous art

The Gretz '413 patent is non-analogous art. The Gretz '413 device does not simply *frame* an article inset (such as a light fixture) within a cutout of a structure, rather it is an electrical box to which electrical devices are *mounted*.

To support a valid rejection under 35 U.S.C. 103 the cited art must suggest that it can accomplish the Applicant's results. Ex parte Tanaka, Marushima and Takahashi, 174 U.S.P.Q. 38 (Pat. Off. Bd. App. 1971). It is well settled that an inventive combination cannot be anticipated by finding individual features separately in the prior art and combining them in a piecemeal manner to show obviousness. See In re Kamm and Young, 17 U.S.P.Q. 298, *affd.*, which appears most pertinent to the issues at hand and wherein the claims were also rejected

over a combination of references. The Court held that "[t]he rejection here runs afoul of a basic mandate inherent in section 103 - that a piecemeal reconstruction of the prior art patents in the light of appellants disclosure shall not be the basis for a holding of obviousness." There simply is no purpose or means for combining the Lackey '853 cover, the Kelmelis et al. '846 lighting system, and the Gretz '413 electrical box to arrive at the accent frame of the present invention, which is formed by injection molding as in claim 11. Hence, claim 11 is patentably distinguished on its own merits. Additionally, claim 11 depends on claim 1, and as stated above the combination of Lackey '853 and Kelmelis et al. '846 does not arrive at claim 1. Thus, depending claim 11 is likewise patentably distinguished.

For the reasons set forth herein, it is believed that the Examiner erred and that this application clearly and patentably distinguishes over the prior art and is in proper condition for allowance. Reversal is respectfully requested.

* * *

Respectfully submitted,



Royal W. Craig
Reg. No. 34,145
(410) 347-7303
Attorney for Applicant
Date March 19, 2007

Ober, Kaler, Grimes & Shriver
120 East Baltimore Street, Suite 800
Baltimore, MD 21202-1643

In re U.S. Utility Patent Application of Horton, Wade C.

Art Unit: 3637

Appln. No. 10/825,836

Page -12-

APPENDIX A: CLAIMS UNDER APPEAL

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1. An accent frame for framing an article inset within a cutout of a structure, said inset article including a finishing ring for providing a transition from said article to said structure; said accent frame comprising:

a rigid thin sheet of material larger in size than the finishing ring, said rigid thin sheet having an outer edge defining an object-shape and a convex inner edge defining an aperture having a lip for proper positioning with said cutout, wherein said cutout comprises slots and said finishing ring comprises expandable tension clips for insertion through said aperture and said slots thereby securing said frame in place between said finishing ring and about the cutout and against the structure;

whereby said accent frame serves as an aesthetically pleasing backdrop to said finishing ring and serves to cover up any imperfections in the finish or cut of the surrounding structure.

2. The accent frame of claim 1, further comprising a decorative outer edge.
3. The accent frame of claim 1, wherein said accent frame is seated flush with said structure.
4. The accent frame of claim 1, wherein said frame flares slightly away from structure to provide an aesthetically pleasing depth or texture to the frame.
5. (Canceled)

6. The accent frame of claim 1, wherein said thin sheet of material is approximately 1 mm thick.

7. The accent frame of claim 1, wherein said article is a recessed lighting fixture.

8. (Withdrawn)

9. The accent frame of claim 1, wherein said structure is a ceiling, wall or floor.

10. The accent frame of claim 1, wherein said frame is constructed of wood, metal or plastic materials.

11. The accent frame of claim 1, wherein said frame is formed by injection molding.

12. (Canceled)

13. The accent frame of claim 1, wherein said frame is both decorative and covers up any imperfections in the edges of the cutout not covered by the finishing ring.

14. The accent frame of claim 1, wherein said object-shape is a star, flower, or house.

In re U.S. Utility Patent Application of Horton, Wade C.

Art Unit: 3637

Appln. No. 10/825,836

Page -15-

APPENDIX B: EVIDENCE APPENDIX

APPENDIX B: EVIDENCE APPENDIX

There has been no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132
nor any other evidence entered by the Examiner and relied upon by appellants in the appeal.

In re U.S. Utility Patent Application of Horton, Wade C.

Art Unit: 3637

Appln. No. 10/825,836

Page -17-

APPENDIX C: RELATED PROCEEDINGS APPENDIX

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As stated above, there are no related appeal proceedings, nor any decisions rendered by a court or the Board in any related appeal proceeding.